

REMARKS

This Amendment and Response is responsive to a final Office Action mailed on June 29, 2005. Claims 45-57 are pending in the application.

Claims 45-57 were rejected in the Office Action. Claims 45, 50, 56, and 57 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,154,201 to Levin, *et al.* (hereinafter referred to as “Levin”). Claims 45-49, 51, and 53-55 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,686,901 to Rosenberg (hereinafter referred to as “Rosenberg”). Claim 52 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Rosenberg in view of U.S. Patent No. 6,563,487 to Martin et al (hereinafter referred to as “Martin”).

Applicant has amended claim 45. No new matter is added by this amendment and support for the amendment may be found in the specification and claims as filed. Applicant submits that claims 45-57 are allowable. Reconsideration of the claims is respectfully requested in view of the following remarks.

Claims 45, 50, 56 and 57 – § 102(e)

The rejection of claims 45, 50, 56 and 57 under 35 U.S.C. § 102(e) as being allegedly anticipated by Levin is respectfully traversed.

To anticipate a claim under 35 U.S.C. § 102(e), a reference must disclose each and every element of the claim. *See* M.P.E.P. § 2131.

Claim 45 recites, in part, “a sensor configured to sense a state of said remotely-controlled device.” The system of Levin does not comprise a sensor for detecting a state of the remotely-controlled device. The system of Levin is capable of detecting a state of the manipulandum, but that is not the same as “a sensor configured to sense a state of said remotely-controlled device.” As such, Levin does not disclose each and every element claim 45. Thus, Levin does not anticipate claim 45 and claim 45 is patentable over Levin.

Therefore, Applicant respectfully requests the Examiner withdraw the rejection to claim 45. Further, because claims 50, 56 and 57 depend from and further limit claim 45,

Applicant submits that these claims are patentable at least for the reasons stated.

Therefore, Applicant respectfully requests the Examiner withdraw the rejection to claims 50, 56 and 57 .

Claims 45-49, 51 and 53-55 – § 102(e)

The rejection of claims 45-49, 51 and 53-55 under 35 U.S.C. § 102(e) as being allegedly anticipated by Rosenberg is respectfully traversed.

To qualify as prior art under 35 U.S.C. § 102(e), a reference must have a different inventive entity than the pending application. *See* 35 U.S.C. § 102(e), M.P.E.P. § 2136.04.

Respectfully, the Rosenberg reference is not available as a prior art reference because it has the same inventive entity as the present pending application. The inventive entity listed on the face of the Rosenberg patent consists solely of Louis B. Rosenberg. Likewise, the inventive entity in the present application consists solely of Louis B. Rosenberg. As the inventive entity is identical for both the Rosenberg patent and the present application, the Rosenberg patent is not “by another” as required by 35 U.S.C. § 102(e) and M.P.E.P. § 2136.04, and is therefore not available as prior art under 35 U.S.C. § 102(e).

Applicant respectfully requests the Examiner withdraw the rejection of claims 45-49, 51 and 53-55.

Claim 52 – § 103(a)

The rejection of claim 52 under 35 U.S.C. § 103(a) as unpatentable over Rosenberg in view of Martin is respectfully traversed.

As pointed out above, Rosenberg is not available as prior art under 35 U.S.C. § 102(e) and therefore cannot be used as a basis for a rejection under 35 U.S.C. § 103(a). Further, “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject

to an obligation of assignment to the same person.” 35 U.S.C. § 103(c). The present invention has been assigned to the Immersion Corporation. The Martin reference has also been assigned to Immersion Corporation and is thus not a proper reference under 35 U.S.C. § 103(a). Therefore, the rejection is not based on proper prior art and is improper.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 52.

CONCLUSION

Applicant respectfully asserts that in view of the amendments and remarks above, all pending claims are allowable and Applicant respectfully requests the allowance of all claims.

Should the Examiner have any comments, questions, or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Date: 12/23/2005

Respectfully submitted,



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